

**REMARKS**

Claims 38-88 are presently pending and under consideration in the above-identified application. Claims 38, 42, 45-51, 54, 55, 57, 58-61, 68, 71-77, 79-85, 87 and 88 have been amended above. Claims 44, 52, 62, 78 and 86 have been cancelled. New claims 89-99 have been added. Upon entry of the amendment, claims 38-43, 45-51, 53-61, 63-77 and 79-99 will be pending and under consideration.

The Office Action indicates at page 3, final paragraph, that the original specification provides sufficient written description of an chromatin remodeling complex selected from SWI/SNF, RSC, NURF, CHRAC, ACF, NURD and RSF. The Office Action further indicates that sufficient written description is provided for SWI/SNF subunits associated with a domain of nucleic acid regulatory proteins (page 3, last paragraph). The Office Action further concedes that the specification enables the claimed methods with regard to an SWI/SNF chromatin remodeling complex (page 6, first full paragraph).

Base claim 38, as amended herein, is directed to a method for identifying a test compound that modulates chromatin remodeling of a specific DNA sequence within chromatin by providing one or more subunits of an SWI/SNF chromatin remodeling complex associated with a domain of a nucleic acid regulatory protein, by contacting the subunits with the test compound and determining whether there is an increase or decrease in the interaction between the subunits and the domain of the transcription factor.

Base claim 63, as amended herein, is directed to a method for identifying a test compound that modulates chromatin remodeling of a specific DNA sequence within chromatin

by providing chromatin assembled DNA containing the specific DNA sequence, contacting the chromatin assembled DNA with one or more subunits of an SWI/SNF chromatin remodeling complex, a domain of a nucleic acid regulator protein; and determining the level of chromatin remodeling in the presence and absence of the test compound.

Based on the indication that Applicant's method claims directed to SWI/SNF are adequately described and enabled to meet the requirements of the first paragraph of section 112 of the Code, claims 38 and 63 have been amended herein to incorporate all elements of dependent claims 44 and 70, respectively, both of which have been cancelled. As amended, base claims 38 and 63 recite SWI/SNF chromatin remodeling complexes and effectively replace dependent claims 44 and 70, neither one of which stands rejected by the Office. Applicant notes that claims 43-47 and 70-73 have only been objected to for depending on rejected claims and have been indicated in the current Office Action as being "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." (page 14, *Conclusion*)

Support for the amendment to claim 38 can be found throughout the application including, for example, at page 5, lines 6-21. Support for the amendment to claim 63 can be found throughout the application including, for example, at page 5, lines 6-21 and at page 6, lines 7-12. Dependent claims 45 and 71 have been amended to independent format without any addition of newly recited subject matter. Claims 46-51, 54, 55, 57, 58-61, 72-77, 79-85, 87 and 88 have been amended merely to correct dependency in view of the amended base claims. Claims 42, 57, 68 and 83 have also been amended to correct typographical errors. New claims 89-99 have been added to have identical dependent claims for base claims 45 and 71 as are

present for base claims 38 and 63. Accordingly, the amendments do not raise any issues of new matter and entry thereof is respectfully requested.

Applicant has reviewed the rejections set forth in the Office Action mailed October 8, 2003, and respectfully traverse all grounds for the reasons that follow.

**Regarding the Election/Restriction**

Withdrawn claims 52, 62, 78 and 86, which are directed to non-elected subject matter have been cancelled herein without prejudice.

**Regarding the Claim Objections**

Claims 42 and 68 have been amended herein to correctly spell the term "motif." Accordingly, Applicant respectfully requests withdrawal of the objection to claims 42 and 68.

Claims 57 and 83 have been amended herein as requested in the present Action (page *Claim Objections*, second paragraph) by replacing the bracket behind the abbreviation "LCR" with a closed parenthesis. Accordingly, Applicant respectfully requests withdrawal of the objection to claims 57 and 83.

**Rejections Under 35 U.S.C. § 112**

***A. Written Description***

The rejection of claims 38-43, 48-51, 53-61, 63-69, 74-77, 79-85 and 87-88 under 35 U.S.C. § 112, first paragraph, as allegedly lacking written description respectfully is traversed.

Briefly, the Office argues that the specification provides sufficient description for chromatin remodeling complexes selected from SWI/SNF, RSC, NURF, CHRAC, ACF, NURD and RSF, but does not similarly provide sufficient written description of a representative number of subunits of chromatin remodeling complexes associated with a nucleic acid regulatory protein (paragraph bridging pages 5 and 6).

Applicant maintains that the specification provides sufficient written description for the subject matter of claims 38-43, 48-51, 53-61, 63-69, 74-77, 79-85 and 87-88. Nevertheless, the instant rejection has been rendered moot by amendment of claims 38 and 63, which have been amended to recite all elements of claims 44 and 70, respectively. As set forth above, amended base claims 38 and 63 are directed to subject matter deemed sufficiently described by the Office. Furthermore, since claims 44 and 70 are not subject to the instant rejection, incorporation of the non-rejected subject matter of these dependent claims into base claims 38 and 63, respectively, effectively renders moot the instant rejection. Accordingly, Applicant respectfully requests removal of the rejection.

***B. Enablement***

The objection to the specification and corresponding rejection of claims 38-43, 48-51, 53-61, 63-69, 74-77, 79-85 and 87-88 under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification so as to enable one skilled in the art to practice the claimed invention is respectfully traversed.

The current Office Action states that the specification, while enabling for a method of identifying a test compound that modulates the chromatin remodeling complex SWI/SNF, does

not provide enablement for using a genus of one or more subunits of a chromatin remodeling complex (page 6, first full paragraph).

Applicant maintains that the specification sufficiently enables the full scope of claims 38-43, 48-51, 53-61, 63-69, 74-77, 79-85 and 87-88. Nevertheless, the instant rejection has been rendered moot by amendment of claims 38 and 63, which have been amended to recite all elements of claims 44 and 70, respectively. As set forth above, amended base claims 38 and 63 are directed to subject matter deemed sufficiently enabled by the Office. Furthermore, since claims 44 and 70 are not subject to the instant rejection, incorporation of the non-rejected subject matter of these dependent claims into base claims 38 and 63, respectively, effectively renders moot the instant rejection. Accordingly, Applicant respectfully requests removal of the rejection.

In view of the above, Applicant requests removal of the independent rejections of claims 38-43, 48-51, 53-61, 63-69, 74-77, 79-85 and 87-88 under 35 U.S.C. § 112, first paragraph, as lacking written description and enablement.

### **CONCLUSION**

In light of the Amendments and Remarks herein, Applicant submits that the claims are in condition for allowance and respectfully requests a notice to this effect. Should the Examiner have any questions, he is invited to call the undersigned attorney.

Serial No.: 09/781,592

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



Astrid R. Spain

Registration No. 47,956

4370 La Jolla Village Drive, Suite 700  
San Diego, CA 92122  
858.535.9001 ARS:cej  
Facsimile: 858.597.1585  
**Date: November 8, 2004**